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EXAMINER

HAYES, JOHN W

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 01/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/040,176

Applicant(s)

PERKOWSKI, THOMAS J.

Examiner

John W Hayes

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 September 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Other Remarks

1. Examiner has conducted an inventor name search which returned a list of 53 applications that appear to be related. Examiner requests applicant's assistance in identifying all related pending, allowed or issued applications with similar claim language so that all potential Double Patenting issues can be properly identified and handled.

Specification

2. The disclosure is objected to because it contains embedded hyperlinks and/or other form of browser-executable code. See Specification, page 6, line 3; page 7, line 19; page 32, line 16; page 35, lines 14 and 23 and page 86, line 22. The attempt to incorporate subject matter into the patent application by reference to a hyperlink and/or other forms of browser-executable code is considered to be an improper incorporation by reference. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01(p), paragraph I regarding incorporation by reference.
3. The disclosure is objected to because Figure 3B and 3C are not included in the List of Figures. Also, there is no Figure 3D as referenced by the specification (Page 23). Appropriate correction is required.

Claim Objections

4. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not). In this case, applicant has requested the cancellation of claims 20-39 in the preliminary amendment filed 25 October 2001 and added new claims 51-72. However, neither claims 20-39 nor claims 40-49 ever existed in this case. Thus, claims 51-72 have been renumbered to 20-41 respectively.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 12-14, 19, 20 and 27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per claims 12 and 13, the use of "and/or" on line 6 (claim 12) and line 10 (claim 13) is indefinite. It is unclear if the claim is to be limited as if it were an "and" or an "or". Given is broadest reasonable interpretation, the word "or" is functionally equivalent to "and/or"; therefore, Examiner suggests replacing "and/or" with either "and" or "or".

As per claims 13, 14 and 19, parenthetical expressions appear in lines 3-5, 11 and 12 (claim 13), line 4 (claim 14) and lines 4, 5, 12 and 13 (claim 19). It is unclear whether the parenthetical expressions are meant to limit the claim or to what extent; therefore, claims 13 and 19 are indefinite. Examiner suggests removing the parenthetical expressions.

As per claims 13 and 19, the language "in retail stores, at home, in the office and on the road" in lines 9-10 (claim 13) and lines 10-11 (claim 19) is vague and indefinite. It is unclear how this language is intended to further limit the actual structure or method steps recited in the claims.

As per claim 19, the term "and/or" is also used in lines 10 and 13 and is rejected for the same reasons as stated above.

As per claim 20, the term "and/or" is also used in lines 30, 34 and 36 and is rejected for the same reasons as stated above.

As per claim 27, the term "and/or" is also used in lines 36, 38 and 40 and is rejected for the same reasons as stated above.

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Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

8. Claims 1-7 and 14 are rejected under 35 U.S.C. 102(e) as being anticipated by *Hudetz et al*, U.S. Patent No. 5,978,773.

As per **Claims 1-7**, *Hudetz et al* discloses an Internet based system comprising:

A database management subsystem for storing and managing UPN/URL link information representative of a plurality of UPNs (UPCs) placed on a plurality of consumer products (Figures 1 and 4; Col. 7, lines 1-42)

A plurality of URLs symbolically linked to the UPNs by the manufacturers and specifying the location of a plurality of Web documents stored in one or more Internet based information servers, and published by manufacturers and containing particular kinds of information related to consumer products on the UPNs are placed and used in commerce (Figure 4 and Col. 7, lines 17-28)

A UPN/URL information server operably connected to the database and the infrastructure of the Internet, the UPN/URL information server accessing one or more URLs from the UPN/URL link information in the database in response to a request transmitted to the UPN/URL information server by a consumer-operated client computer seeking to find consumer product related information contained in one or more Web documents stored in one or more Internet-based information servers (Figure 1; Col. 7 line 43-Col. 8 line 10; Col. 8, lines 21-50; Col. 9, lines 14-21)

A plurality of Web-enabled consumer product information kiosks installed in a retail environment, each kiosk being connected to the Internet, enabling a consumer to access one or more URLs from the database in response to a request transmitted to the UPN/URL information server for use in accessing multi media consumer product related information contained in Web documents located at one or more URLs (Figure 1; Col. 8, lines 21-50; Col. 9, lines 14-21), the kiosk including a browser program having an

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on-screen product finder button which enables the UPN to be entered into the system (Figures 1-2 and 6).

As per **Claim 14**, Hudetz et al disclose a consumer product information finding system comprising:

At least one kiosk installed within a retail shopping environment (Figure 1; Col. 5, lines 30-35) and each kiosk includes:

A bar code symbol reader for reading the UPC numbers on products being offered for sale in the store (Figures 1-2; Col. 6, lines 7-15);

A LCD touch-type display screen for displaying product related information accessed from hyper-linked Web-sites on the Internet (Figure 6 and Col. 5, lines 25-30).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 8-13 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Hudetz et al*, U.S. Patent No. 5,978,773 in view of *Blinn et al*, U.S. Patent No. 5,897,622.

As per **Claims 8-12**, *Hudetz et al* discloses an Internet based system comprising:

A database management subsystem for storing and managing URL link information representative of a plurality of consumer products (Figures 1 and 4; Col. 7, lines 1-42)

A plurality of URLs symbolically linked to the product information by the manufacturers and specifying the location of a plurality of Web documents stored in one or more Internet based information

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servers, and published by manufacturers and containing particular kinds of information related to consumer products used in commerce (Figure 4 and Col. 7, lines 17-28)

A URL information server operably connected to the database and the infrastructure of the Internet, the URL information server accessing one or more URLs from the URL link information in the database in response to a request transmitted to the URL information server by a consumer-operated client computer seeking to find consumer product related information contained in one or more Web documents stored in one or more Internet-based information servers (Figure 1; Col. 7 line 43-Col. 8 line 10; Col. 8, lines 21-50; Col. 9, lines 14-21)

A plurality of Web-enabled consumer product information kiosks installed in a retail environment, each kiosk being connected to the Internet, enabling a consumer to access one or more URLs from the database in response to a request transmitted to the URL information server for use in accessing multimedia consumer product related information contained in Web documents located at one or more URLs (Figure 1; Col. 8, lines 21-50; Col. 9, lines 14-21), the kiosk including a browser program having an on-screen product finder button which enables the UPN to be entered into the system (Figures 1-2 and 6).

Hudetz, however, fails to specifically disclose that the information stored includes trademark information which is registered with the USPTO. Blinn et al disclose an electronic shopping and merchandising system that provides great flexibility for a merchant to adapt the system to their existing business practices, promotions and databases. *Blinn et al* teaches a method that allows merchants to insert, delete and update remote databases of product information such as a product name which may be considered to be a trademark (Abstract, Col. 2, lines 10-28; Col. 6, lines 31-36; Col. 9, lines 60-63; Col. 19, lines 40-45). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the system of *Hudetz et al* and incorporate the ability to enable the manufacturer or merchant of the products to access a remote database over the Internet and manage and update the information stored in the database, including trademark information. It is well known in the database arts that information stored in databases periodically needs to be updated dynamically in order that the information continue to be current. By enabling manufacturers to update information in their remote

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databases, information related to products that consumers are interested in can be updated as necessary.

As per **Claims 13 and 19**, *Hudetz et al* discloses

A plurality of Web-enabled consumer operated subsystems operably connected with the Internet installed in a retail environment, enabling a consumer to access consumer product-related information from a database in response to reading bar code symbols (Figure 1; Col. 8, lines 21-50; Col. 9, lines 14-21).

Hudetz et al fails to specifically disclose a plurality of manufacturer-managed subsystems operably connected with the Internet, for enabling manufacturers to manage and update within a database, UPNs encoded within bar code symbols applied to consumer products and the URLs of Web documents containing consumer product related information published on the Internet.

Blinn et al discloses an electronic shopping and merchandising system that provides great flexibility for a merchant to adapt the system to their existing business practices, promotions and databases. *Blinn et al* teaches a method that allows merchants to insert, delete and update remote databases of product information (Abstract, Col. 2, lines 10-15; Col. 6, lines 31-36; Col. 9, lines 60-63; Col. 19, lines 40-45). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the system of *Hudetz et al* and incorporate the ability to enable the manufacturer or merchant of the products to access a remote database over the Internet and manage and update the information stored in the database. It is well known in the database arts that information stored in databases periodically needs to be updated dynamically in order that the information continue to be current. By enabling manufacturers to update information in their remote databases, information related to products that consumers are interested in can be updated as necessary.

11. Claims 15-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Hudetz et al*, U.S. Patent No. 5,978,773.

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As per **Claims 15 and 18**, Hudetz et al fails to specifically disclose wherein the bar code symbol reader projects a 3-D laser scanning pattern over the touch-screen panel or wherein the bar code scanner has a cordless interface. However, examiner takes Official Notice that it was well known at the time of applicant's invention that bar code scanners may be wireless and that they projected a 3-D laser scanning pattern and it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to include a bar code scanner that uses this technology since it was widely used and readily available.

As per **Claims 16-17**, Hudetz et al further discloses the use of a modem in the kiosk which clearly may be used to carry out phone calls, however, does not disclose the use of a telephone handset or a credit card transaction terminal. Examiner takes Official Notice that it was well known at the time of applicant's invention to attach a telephone handset to a kiosk for use in making telephone calls and using credit card transaction devices and it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to include the telephone handset or credit card transaction device for this added convenience.

12. Claims 20-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Hudetz et al*, U.S. Patent No. 5,978,773 in view of *Blinn et al*, U.S. Patent No. 5,897,622 and Cragun et al, U.S. Patent No. 5,804,803

As per **Claims 20-23, 27-31**, Hudetz et al disclose method of creating and managing UPN/PD/URL data links relating to the consumer products of a manufacturer, and transporting said UPN/PD/URL data links to a central relation database management system (RDBMS) so that consumers can access and use said UPN/PD/URL data links to find consumer product related information resources on the Internet which have been referenced by the manufacturer and/or its agents, said method comprising the steps of:

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(a) storing in a central relational database management system (RDBMS) (Figure 1), information elements representative of

(1) a plurality of universal product numbers (UPCs) assigned to a plurality of consumer products associated with a manufacturer and registered with said local RDBMS (Figure 4; Col. 7, line 1-Col. 8 line 10), and

(2B) a product description (PD) symbolically linked to each said UPN (Figure 4; Col. 7, line 1-Col. 8 line 10), and

(2C) a plurality of uniform resource locators (URLs) symbolically linked to each said UPN (Figure 4; Col. 7, line 1-Col. 8 line 10),

wherein each said URL specifies the location of an information resource located on the Internet and related to a particular consumer product of said manufacturer (Figure 4; Col. 7, line 1-Col. 8 line 10), and

wherein a UPN/PD/URL data link is created and maintained in said local RDBMS for each consumer product registered with said local RDBMS so as to maintains plurality of UPN/PD/URL data links in said local RDBMS for said plurality of consumer products of said manufacturer (Figure 4; Col. 7, line 1-Col. 8 line 10);

(b) transporting said plurality of UPN/PD/URL data links to a central relational database management system (RDBMS), via a telecommunication link, so as to register said plurality of consumer products of said manufacturer with said central RDBMS (Figure 1; Col. 7, line 1-Col. 8 line 10);

(c) operably connecting an Internet database server to said central RDBMS and the infrastructure of the Internet, so as to enable said Internet database server to service a request made by an Internet-enabled client system, for information on the Internet about one of said plurality of consumer products registered with said central RDBMS (Figure 1; Col. 7, lines 42-50);

(d) operably connecting an Internet-enabled client system with a browser (Col. 8, lines 20-25) to the infrastructure of the Internet so as to enable a consumer to transmit a request for consumer product information on the Internet about a consumer product registered with said central RDBMS, wherein each said request may include either the UPN and/or PD symbolically linked to the UPN assigned to a

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registered consumer product on which consumer product information on the Internet is being sought by a consumer using said Internet-enabled client system (Figure 1; Col. 5, lines 13-20 and 48-55; Col. 8, lines 21-46);

(e) receiving at said Internet database server, the request transmitted by said Internet enabled client system, and recovering the UPN and/or PD contained in said request so as to enable said Internet database server to access said plurality of URLs symbolically linked to the UPN and/or PD and stored in said central RDBMS, and then transmit said accessed plurality of URLs to said Internet-enabled client system (Col. 8, lines 29-49); and

(f) displaying said plurality of URLs on said Internet-enabled client system, and enabling the consumer to select any one or more of said displayed URLs to access the corresponding information resources stored in Internet-based product information servers, at the selected URLs (Col. 8 line 47-Col. 9 line 22).

Hudetz, however, fails to specifically disclose that the information stored includes trademark information. Blinn et al disclose an electronic shopping and merchandising system that provides great flexibility for a merchant to adapt the system to their existing business practices, promotions and databases. *Blinn et al* teaches a method that allows merchants to insert, delete and update remote databases of product information such as a product name which may be considered to be a trademark (Abstract, Col. 2, lines 10-28; Col. 6, lines 31-36; Col. 9, lines 60-63; Col. 19, lines 40-45). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the system of *Hudetz et al* and incorporate the ability to enable the manufacturer or merchant of the products to access a remote database over the Internet and manage and update the information stored in the database, including trademark information. It is well known in the database arts that information stored in databases periodically needs to be updated dynamically in order that the information continue to be current. By enabling manufacturers to update information in their remote databases, information related to products that consumers are interested in can be updated as necessary.

Hudetz et al discloses the use of a remote, central database to store product information and transporting information to this database in order to maintain/update the database. Hudetz et al,

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however, fail to disclose storing this information in a local database. Cragun et al disclose a local database for storing product information (Figures 1B and 3). Cragun et al further disclose that this database is not required to be local, but may also be located in any server in the external network (Col. 11, lines 55-61). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Hudetz et al and include both a local database for those users that are local and have no need to access an external network and a remote, central database that can be accessed by external users such as that disclosed by Hudetz et al. One would be motivated to include both types of databases in order to serve both types of customers and implement a flexible design that supports any type of customer connectivity.

As per **Claims 24-25 and 32-33**, *Hudetz et al* fails to disclose using a file transfer protocol or electronic data interchange process to transmit information from the manufacturer-managed system to the database management system. *Blinn et al* discloses using an electronic data interchange (EDI) for transmitting information (Col. 15, lines 15-20). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to utilize either EDI or FTP to transfer information or files over a communication medium. These were well known protocols used in the industry and were commonly used.

As per **Claim 26 and 34**, *Hudetz et al* fail to disclose a manufacturer registering with the database and then downloading a computer program producing and managing the database. *Blinn et al* discloses wherein manufacturers register with the database and use software in order to manage the database (Col. 6, lines 25-60; Col. 12 line 57-Col. 13 line 23). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Hudetz et al and include the ability for the manufacture to register with the database and manage the database through the use of software as taught by *Blinn et al* in order to keep the database current as data changes.

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As per Claim 35, Hudetz et al further disclose wherein the consumer product information contained in the information resources includes information items selected from the group consisting of product advertisements, product specifications, product updates, product distributors, product warranty/servicing, and product incentives including rebates, discounts and coupons (Col. 10, lines 2-11).

As per Claims 36-37, Hudetz et al further disclose wherein the Internet enables client computer system, either remote or within a retail environment (Col. 5, lines 30-35) comprises

A GUI-based Web browser program (Col. 8, lines 20-25; Col. 9, lines 57-63);

A bar code symbol reader, operably connected to the GUI based Web browser program for reading bar code symbols placed on consumer products and encoded with UPNs (Figures 1-2 and 8).

As per Claim 38-40, Hudetz et al further disclose wherein said Internet-enabled client computer system is a Web enabled consumer product information (CPI) kiosk installed within a retail environment, for accessing consumer product related information in response to reading UPN-labeled consumer products, said Web-enabled CPI kiosk comprising:

a housing of compact construction (Figures 1, 2 and 6);

a bar code symbol reader, integrated with said housing, for reading a UPN encoded bar code symbol on a consumer product being offered for sale in said retail shopping environment, and producing symbol character data representative of the UPN encoded within said UPN-encoded bar code symbol (Figures 1-2 and 8);

an Internet accessing mechanism, integrated with said housing, responsive to the symbol character data produced from said bar code symbol reader, and automatically accessing from said Internet database server, a plurality of URLs symbolically-linked to the UPN encoded within said UPN-encoded bar code symbol read by said bar code symbol reader (Figure 1); and

a LCD touch type display screen (Figure 6 and Col. 5, lines 25-30), integrated with said housing, for visually displaying said plurality of URLs symbolically-linked to said UPN, and consumer product

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related information resources accessed from said Internet-based product information servers in response to selecting at least one of said URLs displayed on said display screen (Figure 6).

As per **Claim 41**, Hudetz et al does not disclose the use of a credit card transaction terminal.

Examiner takes Official Notice that it was well known at the time of applicant's invention to attach a card reader to terminal devices for use in carrying out credit card transactions and it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to include the credit card transaction device for this added convenience.

Double Patenting

13. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

14. Claims 1-9 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 4-7, and 9 of U.S. Patent No. 5,918,214. Although the conflicting claims are not identical, they are not patentably distinct from each other. Claims 1-9 recite substantially the same features as claims 1, 2, 4-7, and 9 of the patent, however, claims 1 and 5 of the application eliminate recitations of a database server and a plurality of product-information servers. The courts have held that elimination of an element and its function is not an inventive step. *In re Karlson*, 153 USPQ 184 (CCPA 1963). Therefore, the elimination steps and structure would have been obvious to a person of ordinary skill in the art.

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15. Claims 10-12 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 6 and 9 of U.S. Patent No. 5,918,214. Although the conflicting claims are not identical, they are not patentably distinct from each other. Claims 10-12 recite substantially the same features as claims 6 and 9 of the patent, however, claim 10 of the application eliminate recitations of a database server and a plurality of product-information servers. The courts have held that elimination of an element and its function is not an inventive step. *In re Karlson*, 153 USPQ 184 (CCPA 1963).

Therefore, the elimination steps and structure would have been obvious to a person of ordinary skill in the art.

16. Claims 20-41 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4 of U.S. Patent No. 6,631,357 in view of Hudetz et al, U.S. Patent No. 5,978,773. Although the conflicting claims are not identical, they are not patentably distinct from each other. Claims 20 and 27 recite substantially the same features as claims 1-4 of the patent, however, claims 20 and 27 of the application eliminate recitations related to a plurality of Internet based product-information servers, automatically analyzing the requests and contacting the manufacturer and soliciting the manufacturer to register the consumer product with the database. The courts have held that elimination of an element and its function is not an inventive step. *In re Karlson*, 153 USPQ 184 (CCPA 1963). Therefore, the elimination steps and structure would have been obvious to a person of ordinary skill in the art.

Claims 20 and 27 of the present application also differ from claims 1-4 of U.S. Patent No. 6,631,357 since claims 1-4 of U.S. Patent No. 6,631,357 fail to recite the use of a central database for registering consumer product information. Hudetz et al discloses the use of a remote, central database to store product information and transporting information to this database in order to maintain/update the database. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Hudetz et al and include both a local database for those users that are local and have no need to access an external network and a remote, central database that can be accessed by external users such as that disclosed by Hudetz et al. One would be motivated to include both types of

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databases in order to serve both types of customers and implement a flexible design that supports any type of customer connectivity.

Claims 21-26 and 28-41 depend from claims 20 and 27 and are, therefore, rejected under the same rationale.

17. Claims 14-18 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 5,9508,173. Although the conflicting claims are not identical, they are not patentably distinct from each other. Claim 14 recites substantially the same features as claim 1 of the patent, however, claim 14 of the application eliminate recitations of a an Internet access means. The courts have held that elimination of an element and its function is not an inventive step. *In re Karlson*, 153 USPQ 184 (CCPA 1963). Therefore, the elimination steps and structure would have been obvious to a person of ordinary skill in the art.

Conclusion

18. **Examiner's Note:** Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

19. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Wellner discloses an apparatus and method for enabling a user to receive an electronic multimedia service based upon scanning an object and requesting information about the object
- Cragun et al disclose a client computer with a scanner capable of scanning objects wherein the computer translates a code on the object into a URL for receiving information related to the object

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- Tracy et al disclose a portable shopping system including a scanner for scanning objects and providing marketing information to promote the sale of products. Tracy et al also discloses a card reader linked to the customer service console
- Shachar discloses a system for scanning bar codes on products and accessing information regarding the product from the Internet. Shachar also discloses the use of the FTP protocol for downloading or uploading binary files over the Internet
- Knowles discloses a system and method for composing URL-encoded bar code symbols specifying the location of Internet-based information resources on the Internet
- Browning discloses a handheld scanner and accompanying remote access agent for accessing information on the Internet regarding products of interest
- Namekata et al [Japanese Abstract] discloses a method to obtain information about products by scanning a bar code from a home terminal and retrieving information from a data communication network.

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20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Hayes whose telephone number is (703)306-5447. The examiner can normally be reached Monday through Friday from 5:30 to 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jim Trammell, can be reached on (703) 305-9768.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

Any response to this action should be mailed to:

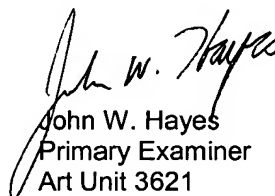
***Commissioner of Patents and Trademarks
Washington D.C. 20231***

or faxed to:

(703) 872-9306 [Official communications; including
After Final communications labeled
"Box AF"]

(703) 746-5531 [Informal/Draft communications, labeled
"PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington,
VA, 7th floor receptionist.


John W. Hayes
Primary Examiner
Art Unit 3621

January 2, 2004